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In re Application of:

PANCHERI, Italo

U.S. Application No.: 10/581,574

PCT No.: PCT/EP2004/053216

International Filing Date: 01 December 2004

Priority Date: 02 December 2003

Attorney's Docket No.: 7878P003

For: SUCTION PUMP FOR LIFTING  
EQUIPMENT

DECISION ON PETITION UNDER  
37 CFR 1.47(b)

This decision is issued in response to the "Petition Under 37 CFR 1.47(a)" filed 27 November 2007, treated herein as a petition under 37 CFR 1.47(b).<sup>1</sup> Petitioner has submitted \$130 as the petition fee; the required petition fee is \$200. Pursuant to the authorization contained in the present petition, Deposit Account No. 02-2666 will be charged the additional \$70 required to complete the petition fee.

**BACKGROUND**

On 01 December 2004, applicant filed international application PCT/EP2004/053216. The application claimed a priority date of 02 December 2003, and it designated the United States. On 16 June 2005, the International Bureau (IB) communicated a copy of the international application to the United States Patent and Trademark Office (USPTO). The deadline for submission of the basic national fee was thirty months from the priority date, i.e., 02 June 2006.

On 02 June 2006, petitioner filed a Transmittal Letter for entry into the national stage in the United States accompanied by, among other materials, payment of the small entity basic national fee.

On 27 April 2007, the United States Designated/Elected Office (DO/EO/US) mailed a Notification Of Missing Requirements (Form PCT/DO/EO/905) indicating that an executed oath or declaration under 37 CFR 1.497 and the surcharge for filing this oath or declaration later than thirty months after the priority date were required.

On 27 November 2007, petitioner filed a response to the Notification Of Missing Requirements, with required five-month extension fee. The response included payment of the

<sup>1</sup> 37 CFR 1.47(b) is the applicable regulation where, as here, petitioner seeks acceptance of the application without the signature of any of the inventors.

required surcharge and the petition considered herein under 37 CFR 1.47(b). The petition requests acceptance of the application without the signature of the sole inventor, whom petitioner states has refused to execute the application papers.

### DISCUSSION

A grantable petition under 37 CFR 1.47(b) must be accompanied by: (1) the fee under 37 CFR 1.17; (2) factual proof that the inventor refuses to execute the application or cannot be reached after diligent effort; (3) a statement of the last known address of the non-signing inventor; (4) an oath or declaration by the 37 CFR 1.47(b) applicant on behalf of and as agent for the non-signing inventor; (5) proof of proprietary interest in the application; and (6) a showing that such action is necessary to preserve the rights of the parties or to prevent irreparable damages. The present petition satisfies items (1) and (3).

Regarding item (1), petitioner has submitted \$130 for the petition fee and authorized a charge to Deposit Account No. 02-266 for required fees. Based on the authorization to charge, petitioner's Deposit Account will be charged the additional \$70 required to complete the required \$200 petition fee. Item (1) is satisfied.

Regarding item (2), where it is asserted that the an inventor has refused to execute the declaration, section 409.03(d) of the MPEP states that a "copy of the application papers should be sent to the last known address of the nonsigning inventor, or, if the nonsigning inventor is represented by counsel, to the address of the nonsigning inventor's attorney." The MPEP also requires "a statement of facts by the person who presented the inventor with the application papers and/or to whom the refusal was made." Here, petitioner has provided a statement from Lorenzo Zanoni, with accompanying exhibits, as evidence of the efforts made to obtain the signature of the non-signing inventor. These materials provide the required firsthand confirmation that a copy of the complete application, with a request for signature, was provided to the non-signing inventor. However, the materials do not demonstrate that the inventor has refused to sign the declaration. Rather, the inventor responded to petitioner's signature request by requesting a copy of the application materials and declaration in Italian; no evidence has been presented showing that petitioner has responded to the inventor's request for a translation of the application materials. Absent further evidence, the above described actions of the inventor (i.e., requesting a copy of the application materials in his native language before signing such materials) cannot be interpreted as a constructive refusal to execute the application. Accordingly, item (2) is not satisfied on the present record.

Regarding item (3), the petition includes an express statement of the last known addresses of the non-signing inventor. Item (3) is satisfied.

Regarding item (4), the petition includes a declaration purportedly executed on behalf of the non-signing inventor by a representative of the 37 CFR 1.47(b) applicant, FAMATEC, S.p.A. ("FAMATEC"). However, the person executing the declaration does not expressly state that he is authorized to act on behalf of FAMATEC, nor does the declaration set forth a title for this person that could provide him with apparent authority (see MPEP section 324(V)). Because the declaration has not been properly executed on behalf of the 37 CFR 1.47(b) applicant, the

declaration is not acceptable in satisfaction of this requirement. Item (4) is therefore not satisfied.

Regarding item (5), section 409.03(f) of the MPEP states the following:

When an application is deposited pursuant to 37 CFR 1.47(b), the 37 CFR 1.47(b) applicant must prove that: (A) the invention has been assigned to the applicant, or (B) the inventor has agreed in writing to assign the invention to the applicant, or (C) the applicant otherwise has sufficient proprietary interest in the subject matter to justify the filing of the application.

Petitioner here asserts that it has the required proprietary interest based on an employment agreement with the inventor. The MPEP states the following with respect to an assertion of proprietary interest based on a contractual agreement to assign, such as an employment agreement:

When an inventor has agreed in writing to assign an invention described in an application deposited pursuant to 37 CFR 1.47(b), a copy of that agreement should be submitted. If an agreement to assign is dependent on certain specified conditions being met, it must be established by a statement of facts by someone with first hand knowledge of the circumstances in which those conditions have been met. A typical agreement to assign is an employment agreement where an employee (nonsigning inventor) agrees to assign to his or her employer (37 CFR 1.47(b) applicant) all inventions made during employment. When such an agreement is relied on, it must be established by a statement of a person having firsthand knowledge of the facts that the invention was made by the employee while employed by the 37 CFR 1.47(b) applicant.

Here, petitioner has provided a copy of an employment agreement entered into by the inventor and FAMATEC; however, this employment agreement does not contain a specific provision requiring the inventor to assign to FAMATEC any inventions made during the course of his employment duties. Moreover, petitioner has not provided any firsthand evidence confirming that the invention underlying the present application was made during the course of the inventor's employment with FAMATEC. Accordingly, the present record does not support the conclusion that the inventor, through his employment contract, has agreed to assign the present application to FAMATEC.

Petitioner also cites a provision of Italian law in support of the assertion of proprietary interest. The MPEP states the following with respect to such an assertion of proprietary interest:

A proprietary interest obtained other than by assignment or agreement to assign may be demonstrated by an appropriate legal memorandum to the effect that a court of competent jurisdiction (federal, state, or foreign) would by the weight of authority in that jurisdiction award title of the

invention to the 37 CFR 1.47(b) applicant. The facts in support of any conclusion that a court would award title to the 37 CFR 1.47(b) applicant should be made of record by way of an affidavit or declaration of the person having firsthand knowledge of same. The legal memorandum should be prepared and signed by an attorney at law familiar with the law of the jurisdiction involved. A copy (in the English language) of a statute (if other than the United States statute) or a court decision (if other than a reported decision of a federal court or a decision reported in the United States Patents Quarterly) relied on to demonstrate a proprietary interest should be made of record.

Petitioner here has not provided a legal memorandum demonstrating that FAMATEC has a proprietary interest in the invention based on applicable law, as required by the MPEP.

Based on the above, petitioner has failed to demonstrate that it has the necessary proprietary interest in the present application. Item (5) is therefore not satisfied.

Regarding item (6), the petition does not include the required statement that granting of the present petition is necessary to preserve the rights of the 37 CFR 1.47(b) applicant. Item (6) is therefore not satisfied.

### CONCLUSION

The petition under 37 CFR 1.47(b) is **DISMISSED** without prejudice.

If reconsideration on the merits of the petition is desired, a proper response must be filed within **TWO (2) MONTHS** of the mail date of the present decision. Any request for reconsideration should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(b)" and must include the materials required to satisfy items (2), (4), (5), and (6) of a grantable petition, as discussed above and in the applicable sections of the MPEP.

Failure to provide a proper and timely response will result in abandonment of the application. Extensions of time are available under 37 CFR 1.136(a).

Please direct further correspondence with respect to this matter to Mail Stop PCT, Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.



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